

### **REMARKS**

Claims 1, 3, 4, 6-11, and 13-23 are pending in this application. The drawings were objected to based on claim 12, and claim 12 was rejected under 35 U.S.C. §112; claim 12 is now canceled, and therefore those issues are moot. Claims 1-23 are provisionally rejected on the grounds of obviousness-type double patenting over Application No. 11/376,983. Claims 1, 3, 4, and 6-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson et al. in view of U.S. Patent Number 5,545,201 to Helland et al. Reconsideration is respectfully requested in light of the following remarks.

#### **Double Patenting Rejection**

The Examiner has provisionally rejected the claims in this application for obviousness-type double patenting over Application Number 11/376,983. Because this is the earlier filed application of the two, a terminal disclaimer is not required and the application is allowable once the other rejections are overcome; a terminal disclaimer will be filed in Application Number 11/376,983 (if necessary) upon allowance of the claims in that application. MPEP §804(I)(B)(1).

#### **Rejection Under 35 U.S.C. §103**

Claims 1, 3, 4, and 6-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson et al. in view of U.S. Patent Number 5,545,201 to Helland et al. Reconsideration is requested.

Applicants' respectfully submit that the pending claims are not obvious in light of Thompson et al. and Helland based on the unexpected results achieved with Applicants' claimed invention. Unexpected results exist, and the claims are therefore not obvious, where the properties in the claimed invention and the prior art differ to such an extent that the difference is classified as a difference in kind, rather than one of degree. In re Waymouth, 499 F.2d 1273, 1276 (CCPA 1974). The title of the Thompson et al. patent is "System for Inducing Tachycardia Utilizing Near-Field T-Wave Sensing". At column 8, lines 22-26, Thompson et al. state "It is seen that this lead provides a distinctive signal which provides a significant improvement for very near-field T-wave detection which, e.g., is important for enhancing the tachy-inducing effectiveness of this

invention.” In addition, at column 8, lines 13-17, Thompson et al. state “By making the electrode spacing less than 1 mm, this electrode configuration provides excellent near field sensing of cardiac signals; it can be used in the atrium for P-wave and atrial repolarization sensing, as well as in the ventricular [sic] for R-wave and T-wave sensing.”

Therefore, the prior art teaches that a lead with a spacing of less than 1 mm between a distal, non-tissue penetrating electrode and a ring electrode achieves improved T-wave sensing. In contrast, as fully supported by the attached Declaration of Yougandh Chitre, Applicants’ claimed invention, by using a tissue-penetrating, helical tip electrode and an inter-electrode spacing of slightly greater than 1 millimeter, significantly attenuates T-wave signals, namely by approximately 75 percent compared to a control lead. This is clearly a difference in kind as opposed to a difference in degree; the prior art teaches improved detection of T-wave signals, whereas Applicants’ claimed invention significantly attenuates T-wave signals. Applicants’ claimed invention doesn’t simply work a little better, it achieves a completely different result, and therefore results in a difference in kind.

In addition, it is well settled that absence of an expected property which a claimed invention would have been expected to possess based on the teachings of the prior art is also evidence of nonobviousness. Ex parte Mead Johnson & Co., 227 USPQ 78 (Bd. Pat. App. & Inter. 1985). As the examiner states in the outstanding Office Action, he believes he has “found a lead that is structurally equivalent” to Applicants’ claimed invention, and he further believes both leads would necessarily operate in the same manner. Because Applicants’ claimed invention unexpectedly attenuates T-waves whereas the prior art teaches improved T-wave detection, there is an absence of an expected property in Applicants’ claimed invention, further bolstering Applicants’ position that the claims are not obvious in light of the prior art.


The results achieved by Applicants’ claimed invention are both unexpected and significant. Accordingly, it is respectfully submitted that the pending claims are nonobvious over the prior art.

**Conclusion**

In light of the above remarks and the accompanying declaration of Yougandh Chitre, it is respectfully submitted that the application is in condition for allowance, and a notice of allowance is requested.

Respectfully submitted,

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Date

  
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